

### **REMARKS**

The Office Action mailed on December 03, 2003, has been reviewed and the comments of the Patent and Trademark Office have been considered. Prior to this paper, claims 1-28 were pending in the present application. By this paper, Applicants do not cancel any claims, and add claim 29. Therefore, claims 1-29 are pending in the present application.

Applicants respectfully submit that the present application is in condition for allowance for the reasons that follow.

### **Drawings**

Formal drawings are hereby submitted with this response and may be found in Appendix A. The formal drawings reflect the drawings on file after the entry of the drawing amendments submitted on September 15, 2003, and remove the shading of Figs. 7 and 8.

### **Specification**

Applicants submit a substitute specification in Appendix B containing subject matter from the original specification and previously entered amendments. Applicants state that the substitute specification contains no new matter. A marked-up version of the substitute specification may be found in Appendix C. Applicants note that this marked-up version of the specification reflects the differences between the originally filed specification and the substitute specification, and all previous amendments to the originally filed specification are shown as changes.

### **Rejections Under 35 U.S.C. § 102**

Claims 1-28 stand rejected under 35 U.S.C. §102(e) as being anticipated by Karpol (USP 6,369,888). In response, Applicants respectfully traverse the rejection of some of the claims, and amend some of the claims without prejudice or disclaimer in order to advance prosecution.

In traversing the rejections, Applicants rely on MPEP § 2131, entitled “Anticipation – Application of 35 U.S.C. 102(a), (b), and (e),” which states that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” It is respectfully submitted that Karpol does not describe each and every element of many of the claims of the present invention, as will be shown below.

Method claims 16-18, 21-22 and apparatus claims 23- 28 recite the use of a **confocal scanning microscope** and the structure of a **confocal scanning microscope**,<sup>1</sup> respectively. Applicants respectfully submit that Karpol does not teach or suggest a confocal scanning microscope. Therefore, Karpol cannot anticipate claims 16-18, and 21-28.

Claim 4, now in independent form, recites a method that includes varying the phase angle of a light field with a modulator, wherein the modulator is at least one of (1) a mirror, (2) a lens or (3) a beam splitter. Karpol fails to teach or suggest use of such a modulator having any of these configurations, and the Office Action does not indicate anything to the contrary. Applicants respectfully submit that claim 4 and the claims that depend from claim 4 (claims 5-7 and 21) are allowable for at least this reason. If the rejection of claim 4 is maintained in view of Karpol, Applicants respectfully request that the PTO identify precisely where in Karpol such an anticipatory teaching may be found.

Furthermore, claim 6 is allowable for at least the additional reason that claim 6 recites movement of the modulator of claim 4 using a control element. Applicants submit that Karpol fails to teach such a method action. If the rejection of claim 6 is maintained in view of Karpol, Applicants respectfully request that the PTO identify precisely where in Karpol such an anticipatory teaching may be found.

Furthermore, claim 7 is allowable for at least the additional reason that claim 7 recites that the control element is a **piezo element**. Applicants submit that Karpol fails to teach use of a piezo element. If the rejection of claim 7 is maintained in view of Karpol, Applicants

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<sup>1</sup> Note that claim 23 recites the “microscope” after the preamble, thus, claim 23 contains a structural recitation claiming a confocal scanning microscope.

respectfully request that the PTO identify precisely where in Karpol such an anticipatory teaching may be found.

Claim 8, now in independent form, recites a method that includes varying the phase angle of a light field with a modulator, wherein the modulator influences a laser light source. In an exemplary embodiment, a modulator is used to switch the laser light source on and off in a manner corresponding to modulation of a pump current of the laser. Further by way of exemplary embodiment, the modulator may sinusoidally modulate the pump current of a diode laser so that the light power emitted by the diode laser is periodically modified.

Karpol fails to teach or suggest use of such a modulator to influence a laser light source, and the Office Action does not indicate anything to the contrary. Applicants respectfully submit that claim 8 and the claims that depend from claim 8 (claims 9-13) are allowable for at least this reason. If the rejection of claim 8 is maintained in view of Karpol, Applicants respectfully request that the PTO identify precisely where in Karpol such an anticipatory teachings may be found.

Claims 19 and 20, now in independent form, recite a method that includes varying the phase angle of a light field with a modulator, wherein a control unit of an AOTF (acousto-optical tunable filter) or an AOBS (acousto-optical beam splitter) is used during the method. Karpol fails to teach or suggest use of such filters/beam splitters, and the Office Action does not indicate anything to the contrary. Applicants respectfully submit that claims 19 and 20 are allowable for at least this reason. If the rejection of either or both of claims 19 and 20 is maintained in view of Karpol, Applicants respectfully request that the PTO identify precisely where in Karpol such anticipatory teachings may be found.

Claim 1 stands amended to affirmatively recite that the method is used with a microscope. Applicants respectfully submit that Karpol does not meet the requirements of MPEP § 2131, which, as noted above, states that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” It is respectfully submitted that Karpol does not expressly or inherently describe a microscope. Therefore, claim 1 cannot be anticipated by Karpol.

Further, claims 2, 3 and 14-15, all of which depend from claim 1, also cannot be anticipated by Karpol. Allowance of these claims is respectfully requested.

**New Claim**

Applicants have added new claim 29. Claim 29 is allowable at least due to the pertinent reasons discussed above. Allowance is respectfully requested.

**Request For Interview**

Applicants' representative will contact examiner Fuller subsequent to the filing of this response to arrange an in-person interview to discuss this case.

**Any Next Office Action Should Not Be A Final Office Action**

As noted above, claims 4-13 and 16-28 are allowable in view of the Karpol reference. The amendments to claims 4, 8, 19 and 20 merely serve to place these allowable claims into independent form, and thus do not constitute an amendment that might necessitate a new grounds for rejection.

If these claims are not allowed and are rejected based on any new grounds of rejection in any next office action, Applicants respectfully submit that any next office action should be a **non-final** office action.

**Conclusion**

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

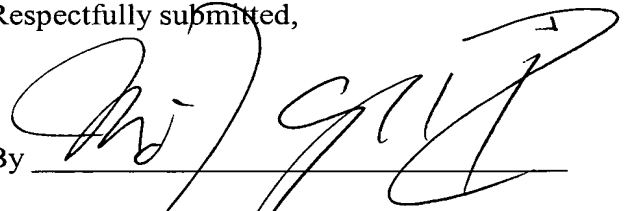
The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of

papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner Fuller is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

By

  
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